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LUD 5664 US (10017134)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : DUMOUTIER, et al

Serial No. : 09/626,617

Filed : July 27, 2000

For : ISOLATED NUCLEIC ACID MOLECULES WHICH
ENCODE T CELL INDUCIBLE FACTORS, OR
INTERLEUKIN-21, THE PROTEINS ENCODED, AND USES
THEREOF

Group Art Unit : 1644

Examiner : A. Decloux

July 22, 2002

Hon. Commissioner of Patents
and Trademarks
Washington, D.C. 20231

**LETTER RESPONSE
TO ADVISORY ACTION
AND TELEPHONIC INTERVIEWS**

This follows the advisory action dated July 9, 2002. That advisory action indicated that the examiner would not enter the amendment of April 18, 2002, because of claim 32. The examiner stated that the subject matter of claim 32 presented issues that would require a new search.

This is not understood, and as was explained to the examiner, is clearly improper.

Originally presented claim 1 reads as follows.

A method for stimulating expression of a STAT transcription factor comprising contacting a cell capable of said expression with an amount of IL-TIF/IL-21 to said cell sufficient to stimulate said expression.

This claim was examined, and was found free of the prior art. No prior art has been applied to any claim presented in this case.

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MPEP 904.01(a) states as follows:

"Substantially every claim includes within its breadth of scope one or more variant embodiments that are not disclosed in the application, but would anticipate the claimed invention if found in a reference. The claim must be so analyzed and any such variant encountered during the search should be recognized."

Following the MPEP's own guidelines, as quoted supra, applicants are entitled to assume that the subject matter of claim 32 was, in fact searched. As such, claim 32 should be entered, as should the entire amendment.

The examiner indicated during the telephone interview that she would be making a written description requirement rejection of the claims. This, too, would be improper.

The present application is a CIP of Serial No. 09/419,568. The 09/419,568 application was incorporated by reference in its entirety. See page 1 of the application.

The 09/419,568 application contains extensive written description of species that are within the genus of the claims. Further, the disclosure of the 09/419,568 application is well within the PTO's own Written Description Guidelines. The examiner's attention is drawn to example 9 of the written description guidelines, a copy of which is attached. The example notes that written description was found for the broadly claimed genus, with one disclosed species. In 09/419,568, applicants disclose more than one species. Hence, it is not seen why the PTO's own guidelines do not apply here.

Should the examiner disagree then a detailed explanation of why the PTO's own guidelines are not applicable is required.

To facilitate review, the 09/419,568 application has issued as U.S. Patent No. 6,331,613, and a copy is attached hereto.

Given the foregoing, it is the applicants' position that (i) the amendment must be entered, and (ii), the application should be allowed. Prosecution should not be re-opened.

Applicants request conformation that the amendment will be entered, no later than July 29, so as

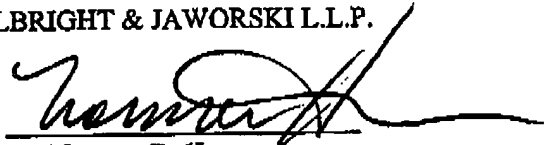
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to provide sufficient time for them to petition from the denial entry of the amendment if the examiner maintains this untenable position.

Respectfully submitted,

FULBRIGHT & JAWORSKI L.L.P.

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e.g. expression vectors, the necessary common attribute is the ORF (SEQ ID NO: 2).

Weighing all factors including (1) that the full length ORF (SEQ ID NO: 2) is disclosed and (2) that any substantial variability within the genus arises due to addition of elements that are not part of the inventor's particular contribution, taken in view of the level of knowledge and skill in the art, one skilled in the art would recognize from the disclosure that the applicant was in possession of the genus of DNAs that comprise SEQ ID NO: 2.

Conclusion: The written description requirement is satisfied.

Example 9: Hybridization

Specification: The specification discloses a single cDNA (SEQ ID NO:1) which encodes a protein that binds to a dopamine receptor and stimulates adenylate cyclase activity. The specification includes an example wherein the complement of SEQ ID NO: 1 was used under highly stringent hybridization conditions (6XSSC and 65 degrees Celsius) for the isolation of nucleic acids that encode proteins that bind to dopamine receptor and stimulate adenylate cyclase activity. The hybridizing nucleic acids were not sequenced. They were expressed and several were shown to encode proteins that bind to a dopamine receptor and stimulate adenylate cyclase activity. These sequences may or may not be the same as SEQ ID NO: 1.

Claim:

An isolated nucleic acid that specifically hybridizes under highly stringent conditions to the complement of the sequence set forth in SEQ ID NO: 1,

wherein said nucleic acid encodes a protein that binds to a dopamine receptor and stimulates adenylate cyclase activity.

Analysis:

A review of the full content of the specification indicates that the essential feature of the claimed invention is the isolated nucleic acid that hybridizes to SEQ ID NO: 1 under highly stringent conditions and encodes a protein with a specific function. The art indicates that hybridization techniques using a known DNA as a probe under highly stringent conditions were conventional in the art at the time of filing.

The claim is drawn to a genus of nucleic acids all of which must hybridize with SEQ ID NO: 1 and must encode a protein with a specific activity.

The search of the prior art indicates that SEQ ID NO: 1 is novel and unobvious.

There is a single species disclosed (a molecule consisting of SEQ ID NO: 1) that is within the scope of the claimed genus.

There is actual reduction to practice of the disclosed species.

Now turning to the genus analysis, a person of skill in the art would not expect substantial variation among species encompassed within the scope of the claims because the highly stringent hybridization conditions set forth in the claim yield structurally similar DNAs. Thus, a representative number of species is disclosed, since highly stringent hybridization conditions in combination with the coding function of DNA and the level of

skill and knowledge in the art are adequate to determine that applicant was in possession of the claimed invention.

Conclusion: The claimed invention is adequately described.

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FACSIMILE TRANSMISSION

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MATTER NUMBER: 10017134

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RE: LUD 5664

NUMBER OF PAGES WITH COVER PAGE: 31

Message:

Jonathan,

As per your telefax of 7/16/02 to Norman, here are the corrected replacement papers for additional inventors.

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